

### REMARKS

This paper responds to the Office Action mailed on July 26, 2007. Claims 40-43 and 46-47 are now pending in this application.

#### Double Patenting Rejection

Claims 32-62 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-39 of co-ending application SN 10/954,764 in view of US 5,741,510. As discussed in Applicant's previous Response, Applicant will consider whether filing a Terminal Disclaimer is appropriate when all claims are indicated to be otherwise allowable and if some overlap arises between the subject matter of the present application and the allowed claims of those other applications.

#### §102 Rejection of the Claims

Claims 40, 41, 43, 46 and 47 were rejected under 35 U.S.C. § 102(b) for anticipation by US 4,592,358. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* '2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in amended claim 40.

Applicant further notes that the therapeutic device 10 disclosed in '358 only describes holding cooling OR heating packets (see '358 at col. 3, line 12, 27, 37). Therefore, Applicant respectfully submits that '358 does not teach or suggest that the first and second patches which

are within the therapeutic device 10 at the same time apply different types of therapy as recited in claim 40. In addition, Applicant respectfully submits that ‘358 does not teach or suggest “a third patch held by said holder, wherein said third patch applies a third therapy . . . , the third therapy being different than the first and second therapies, wherein the first patch, the second patch, the third patch and the flexible wrap are all within the same compartment in the container” as recited in amended claim 41.

The Examiner states at page 8 of the Office Action that “The container does not impart patentable weight with regard to 102 rejection absent functional relationship between the container and the product, and because the product still function equally effectively with or without the container.”

The Examiner also states at page 8 of the Office Action that “The reference teaches three types of therapy: cooling or heating packets or weights for any particular application. Therefore, these patches are disclosed by the prior art.”

The Examiner further states at page 8 of the Office Action that “Regarding applicant's argument that different therapies are applied at the same time, such limitation is directed to the intended use that imparts no patentability to claims directed to product. Recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.”

The Examiner states at pages 8-9 of the Office Action that “In any event, the multiple packs of the prior art can be used to provide different therapies at the same time. For example, cold packs can be used in traumatically injured patient that is suffering from bruise, burn and bone fracture. Cold packs can be applied for these three different injuries to provide different therapies at different sites of the body at the same time.”

Reconsideration and/or allowance of claims 40, 41, 43 and 46-47 are respectfully requested.

*§103 Rejection of the Claims*

Claim 42 was rejected under 35 U.S.C. § 103(a) as being unpatentable over US 4,592,358 in view of US 6,245,347. Applicant respectfully traverses the rejection because the combination of '358 and '347 does not describe each and every element of the claimed invention, and combining '358 with '347 by altering the '358 to include a control apparatus 100 as disclosed in '347 would destroy the stated purpose of '347.

***I. '358 and '347 do not teach or suggest every element of claim 42***

As discussed during the interview, '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in amended claim 40. Applicant further notes that there does not appear to any disclosure in '347 related to a holder or container that secures the disclosed patches. Therefore, Applicant respectfully submits that combination of '358 and '347 does not teach or suggest first and second patches which are within the same compartment in a container at the same time and are able to apply different types of therapy as recited in claim 40.

Applicant notes that claim 42 depends from claim 40, and as such incorporates all of the limitations of claim 40. Therefore, Applicant respectfully submits that the combination of '358 and '347 does not teach or suggest a system as recited in claim 42.

The Examiner states at pages 11-12 of the Office Action that

In this case one having ordinary skill in the art at the time of the invention would have been motivated to provide system for providing therapy to part of the body comprising holder, exothermic packet, endothermic packet, and third packet to be provided to injured portion of the body as disclosed by US '358, and replace the third packet with or further add analgesic patch that advantageously accompanied with cooling or heating means as disclosed by US '347, motivated by the teaching of US '347 that it is advantageously to administer the analgesic patch along with exothermic heating or endothermic cooling devices to control the release and absorption of the analgesic, with reasonable expectation of having system for providing therapy to part of the

body comprising holder, exothermic packet, endothermic packet, and analgesic patch, wherein the system provides relief of the discomfort of the injured area and further provides controlled delivery of analgesic drug to relieve the pain and be involved in the treatment of the injured part of the body, with successful relief of pain or discomfort of the patient.

The Examiner also states at page 12 of the Office Action that “In response to applicant’s argument that placing the control apparatus 100 into the compartments 12 of ‘358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin, it is argued that ‘347 is relied upon for the solely teaching of analgesic patch and for teaching the combination of endothermic, exothermic and analgesic patch in one device.”

## II. Combining ‘358 and ‘347 would destroy the stated purpose ‘347

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

Combining ‘358 with ‘347 by altering the ‘358 to include a control apparatus 100 as disclosed in ‘347 would destroy the stated purpose of ‘347 which is the “**administration of drugs.**” (See ‘347 at column 3, lines 54-56). Applicant notes that placing the apparatus 100 into the compartments 12 of ‘358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin (which is required for the apparatus 100 in ‘347 to function properly).

Since combining ‘358 with ‘347 would destroy the stated purpose of ‘347, the rejection should be withdrawn. Reconsideration and allowance of claim 42 are respectfully requested.

### **CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of

priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21 day of August 2007.

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